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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,290	12/12/2003	Riko Nagai	9683/161	9940
<div>7590 07/03/2007</div> <div>Tadashi Horie Brinks Hofer Gilson & Lione NBC Tower, Suite 3600 P.O. Box 10395 Chicago, IL 60610</div>				
<div>EXAMINER</div> <div>WON, MICHAEL YOUNG</div>				
<div>ART UNIT PAPER NUMBER</div> <div>2155</div>				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/735,290

Applicant(s)

NAGAI ET AL.

Examiner

Michael Y. Won

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>Attached</u> . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/23/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed April 27, 2007.
2. Claims 1, 2, and 4 have been amended and new claims 5-24 have been added.
3. Claims 1-24 have been examined and are pending with this action.
4. Claim 1 previously rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, has been withdrawn.
5. In an attempt to expedite prosecution, the examiner called the applicant's representative Amir Penn (Reg. No. 40,767) to incorporate specific limitations into the pending independent claim. Mr. Penn replied back on June 20, 2007, that the applicants have declined to accept the examiner's request.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1, 3-6, 8, 14-16, 18, and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Yaker (US 6,230,186 B1).

INDEPENDENT:

As per **claim 1**, Yaker teaches a communication device capable of transmitting content to another communication device, comprising:

determining means for determining whether said another communication device has a function for restricting redistribution of content according to redistribution restriction information (see col.4, lines 53-55: "when a sender wants to verify the existence of private message processing functions at the receiver") whereby the another communication device prevents transmitting the content, which was transmitted from the communication device, to a third communication device based on said redistribution restriction information (see col.2, lines 2-5: "so that the private message cannot be edited and retransmitted and col.5, lines 12-34: "the original private text message cannot be edited (cut and paste), retransmitted, or combined..."); and

transmitting means for transmitting said content to which said redistribution restriction information is appended (see col.2, lines 9-10: "A privacy attribute is inserted into at least one of the packets" and Fig.4 and col.4, line 66-col.5, line 8: "These packets, or datagrams containing a privacy attribute, are... put into link 426") when it is determined by said determining means that said another communication device to which said content is to be transmitted is provided with a function for restricting redistribution of said content (see col.1, lines 60-65: "is transmitted to a receiver where

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only certain permitted message processing, called private message processing, may be performed”).

As per **claim 4**, Yaker teaches a transmission restriction method for use in a communication device capable of transmitting content to another communication device, comprising:

detecting an instruction for transmitting said content to said another communication device (see col.5, lines 1-8: “Service provider 410 re-transmits the packet, or datagram... to a destination server, or host 412”) where said content is appended with redistribution restriction information (see col.2, lines 9-10: “A privacy attribute is inserted into at least one of the packets” and col.5, lines 1-8: “containing a privacy attribute”) instructing said another communication device to restrict output of said content to an external device (see col.2, lines 2-5: “so that the private message cannot be edited and retransmitted”);

detecting, after detecting an instruction for transmitting said content, that said another communication device has a redistribution restriction function for restricting output of said content to an external device according to said redistribution restriction information (see col.4, lines 53-55: “when a sender wants to verify the existence of private message processing functions at the receiver”) whereby said another communication device prevents transmitting the content, which was transmitted from the communication device, to the external device according to said redistribution restriction information (see col.5, lines 12-34: “the original private text message cannot be edited (cut and paste), retransmitted, or combined...”); and

transmitting, after detecting that said another communication device has a redistribution restriction function content (see col.1, lines 60-65: "is transmitted to a receiver where only certain permitted message processing, called private message processing, may be performed"), said content to said another communication device (see Fig.4 and col.4, line 66-col.5, line 8: "These packets, or datagrams containing a privacy attribute, are... put into link 426").

DEPENDENT:

As per **claim 3**, which depends on claim 1, Yaker teaches further comprising: redistribution restriction information appending means for appending said redistribution restriction information to said content (see col.2, lines 9-10: "A privacy attribute is inserted into at least one of the packets" and col.5, lines 1-8: "containing a privacy attribute") in response to a user instruction (see col.4, lines 63-66: "the sender activates private message processing function"), wherein said transmitting means transmits to said another communication device said content to which said redistribution restriction information is appended by said redistribution restriction information appending means (see col.2, lines 9-10: "A privacy attribute is inserted into at least one of the packets" and Fig.4 and col.4, line 66-col.5, line 8: "These packets, or datagrams containing a privacy attribute, are... put into link 426").

As per **claims 5 and 18**, which respectively depend on claims 1 and 4, Yaker further teaches wherein said redistribution restriction information comprises information sent from the another communication device to the communication device (see Fig.4:

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interchangeable – “another computer device” can be the sending computer of Fig.4 and the “communication device” can be the receiving computer of Fig.4).

As per **claim 6**, which depends on claim 5, Yaker further teaches wherein said redistribution restriction information comprises identification information of the another communication device (see col.3, lines 13-15: “identifying the sender and the destination”).

As per **claims 8 and 20**, which respectively depend on claims 1 and 4, Yaker teaches further comprising analysis means for analyzing whether the content is subject to restriction in distribution (see col.5, lines 11-13: “upon detection of a privacy attribute”); and wherein the determining means determines whether said another communication device has a function for restricting redistribution of content if the content is subject to restriction in distribution (see col.4, lines 53-55: “when a sender wants to verify the existence of private message processing functions at the receiver”).

As per **claims 14 and 21**, which respectively depend on claims 1 and 4, Yaker teaches further comprising: inquiring means for sending an inquiry to the another communication device to inquire as to whether the another communication device restricts distribution of content; and receiving means for receiving from the another communication device a response to the inquiry including the redistribution restriction information (see col.4, lines 53-55: “when a sender wants to verify the existence of private message processing functions at the receiver”).

As per **claim 15**, which depends on claim 1, Yaker further teaches wherein the redistribution restriction information is included with a request from the another

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communication terminal for the content (see col.2, lines 9-10: "A privacy attribute is inserted into at least one of the packets" and Fig.4 and col.4, line 66-col.5, line 8:

"These packets, or datagrams containing a privacy attribute, are... put into link 426").

As per **claims 16 and 22**, which respectively depend on claims 1 and 4, Yaker further teaches wherein the function for restricting redistribution comprises preventing distribution of the content to the third communication device (see col.2, lines 2-7: "message cannot be edited and retransmitted").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 7, 17, 19, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaker (US 6,230,186 B1) in view of Jordan, Jr. (US 7,228,334 B1).

As per **claim 2**, Yaker teaches a communication device capable of transmitting content to another communication device, comprising:

determining means for determining whether said another communication device has a function for restricting redistribution of content (see col.4, lines 53-55: "when a sender wants to verify the existence of private message processing functions at the receiver") to which redistribution restriction information is appended (see col.5, lines 1-2: "containing a privacy attribute"); and

transmitting means for transmitting said content to which said restriction information is appended (see Fig.4 and col.4, line 66-col.5, line 8: "These packets, or datagrams containing a privacy attribute, are... put into link 426") when it is determined by said determining means that said another communication device to which said content is to be transmitted is provided with a function for restricting redistribution of said content (see col.1, lines 60-65: "is transmitted to a receiver where only certain permitted message processing, called private message processing, may be performed").

Yaker does not explicitly teach wherein said determining means comprises:

acquisition means for acquiring first identification information from said another communication device for identifying whether said another communication device has said function for restricting redistribution of said content; and

memory storage means for storing second identification information for identifying communication devices having said function for restricting redistribution of said content,

wherein said determining means determines whether said first identification information acquired by said acquisition means corresponds to any of second identification information stored in said memory storage means, and decides that said another communication device has said function for restricting redistribution of said content when it is determined that said first identification information acquired by said acquisition means corresponds to any of second identification information stored in said memory storage means.

Jordan, Jr. teaches wherein said determining means comprises:

acquisition means for acquiring first identification information from said another communication device for identifying whether said another communication device has said function for restricting redistribution of said content (see col.5, lines 38-40:

"gateway 115 will interrupt the process and read the message identifier"); and

memory storage means for storing second identification information for identifying communication devices having said function for restricting redistribution of said content (see col.5, lines 30-36: "gateway 115 stores the message identifier associated with the message 16 in a storage medium"),

wherein said determining means determines whether said first identification information acquired by said acquisition means corresponds to any of second identification information stored in said memory storage means, and decides that said another communication device has said function for restricting redistribution of said content when it is determined that said first identification information acquired by said acquisition means corresponds to any of second identification information stored in said memory storage means (see col.5, lines 41-46: "gateway 115 finds a matching entry in storage medium,... blocks forwarding of message 16").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Yaker in view of Jordan, Jr. so that determining means comprises: acquires first identification, stores second identification, and compares identification. One would be motivated to do so because Yaker teaches

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of verifying the existence of a function for processing the private message at the receiver (see col.4, lines 53-55).

As per **claims 7 and 19**, which respectively depend on claims 1 and 4, although Yaker teaches determining by said determining means that said another communication device to which said content is to be transmitted is not provided with the function for restricting redistribution of said content (see claim 1 and claim 4 rejections above), Yaker does not further teach comprising message transmitting means for transmitting a message to said another communication device indicating that the content is not being distributed.

Jordan, Jr. teaches message transmitting means for transmitting a message to said another communication device indicating that the content is not being distributed (see col.5, lines 45-46: "notifies the sender of the forwarded message in step 230 before proceeding").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Yaker in view of Jordan Jr. by implementing transmitting means for transmitting a message to said another communication device indicating that the content is not being distributed. One would be motivated to do so because such means provides the recipient to know that an email delivery was attempted and allows the recipient to take further action in attempting to retrieve the undelivered mail.

As per **claims 17 and 23**, which respectively depend on claims 1 and 4, Yaker does not explicitly teach wherein the function for restricting redistribution comprises

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limiting distribution of the content to external devices to a predetermined number of times.

Jordan, Jr. teaches wherein the function for restricting redistribution comprises limiting distribution of the content to external devices to a predetermined number of times (see col.2, lines 5-11: "sender of an electronic mail message can limit... recipients of that message from forwarding").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Yaker in view of Jordan Jr. by implementing limiting distribution of the content to external devices to a predetermined number of times. One would be motivated to do so because by doing so, Jordan, Jr. teaches that the forward preventing system provides "sufficient flexibility to accommodate a variety of email clients" (see col.1, lines 17-20) rather than only clients with the need to prevent forwarding completely.

As per **claim 24**, Yaker teaches a transmission restriction method for use in a communication device capable of transmitting content to another communication device, comprising:

determining whether said another communication device has a function for restricting redistribution of content (see col.4, lines 53-55: "when a sender wants to verify the existence of private message processing functions at the receiver") to which redistribution restriction information is appended (see col.5, lines 1-2: "containing a privacy attribute"); and

transmitting said content to which said restriction information is appended (see Fig.4 and col.4, line 66-col.5, line 8: "These packets, or datagrams containing a privacy attribute, are... put into link 426") when it is determined that said another communication device to which said content is to be transmitted is provided with a function for restricting redistribution of said content (see col.1, lines 60-65: "is transmitted to a receiver where only certain permitted message processing, called private message processing, may be performed").

Yaker does not explicitly teach wherein said determining means comprises:
acquiring first identification information from said another communication device for identifying whether said another communication device has said function for restricting redistribution of said content; and

storing second identification information for identifying communication devices having said function for restricting redistribution of said content,

wherein determining whether said another communication device has a function for restricting redistribution of content to which redistribution restriction information is appended comprises determining whether said acquired first identification information corresponds to any of the stored second identification information, and deciding that said another communication device has said function for restricting redistribution of said content when it is determined that said acquired first identification information corresponds to any of the stored second identification information.

Jordan, Jr. teaches wherein said determining means comprises:

acquiring first identification information from said another communication device for identifying whether said another communication device has said function for restricting redistribution of said content (see col.5, lines 38-40: "gateway 115 will interrupt the process and read the message identifier"); and

storing second identification information for identifying communication devices having said function for restricting redistribution of said content (see col.5, lines 30-36: "gateway 115 stores the message identifier associated with the message 16 in a storage medium"),

wherein determining whether said another communication device has a function for restricting redistribution of content to which redistribution restriction information is appended comprises determining whether said acquired first identification information corresponds to any of the stored second identification information, and deciding that said another communication device has said function for restricting redistribution of said content when it is determined that said acquired first identification information corresponds to any of the stored second identification information (see col.5, lines 41-46: "gateway 115 finds a matching entry in storage medium,... blocks forwarding of message 16").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Yaker in view of Jordan, Jr. so that determining means comprises: acquires first identification, stores second identification, and compares identification. One would be motivated to do so because Yaker teaches

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of verifying the existence of a function for processing the private message at the receiver (see col.4, lines 53-55).

8. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaker (US 6,230,186 B1) in view of Fishman et al. (US 2002/0103935).

As per **claims 9 and 10**, which respectively depend on claims 1 and 9, Yaker does not explicitly teaches wherein the communication device comprises an electronic mail server.

Fishman teaches wherein the communication device comprises an electronic mail server (see page 6, [0051]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Yaker in view of Fishman such that the communication device comprises an electronic mail server. One would be motivated to do so because one of ordinary skill in the art know that email server are intermediaries for sending and receiving electronic mails.

As per **claim 11**, which depends on claim 10, Yaker further teaches wherein the content comprises at least a portion of an e-mail (see col.1, lines 4-7: "electronic mail"). Yaker does not explicitly teach that the e-mail is transmitted to the electronic mail server.

Fishman teaches wherein the e-mail is transmitted to the electronic mail server (see page 6, [0051]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Yaker in view of Fishman such that the e-mail is transmitted to the electronic mail server. One would be motivated to do so because one of ordinary skill in the art know that email server are intermediaries for sending and receiving electronic mails.

As per **claim 12**, which depends on claim 10, Yaker further teaches wherein the another communication terminal comprises a destination communication terminal, the destination communication terminal identified in the e-mail a recipient of the e-mail (see col.3, lines 13-15).

As per **claim 13**, which depends on claim 9, Yaker does not explicitly teach wherein the communication device comprises a content server.

Fishman teaches wherein the communication device comprises a content server

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Yaker in view of Fishman such that the communication device comprises a content server. One would be motivated to do so because Yaker teaches that the invention is practiced in email communications within intranets or Internet (see col.1, lines 4-7) and content server art components of the Internet.

Response to Arguments

9. Applicant's arguments with respect to claim 1, 3, and 4 have been considered but are moot in view of the new ground(s) of rejection. The newly cited reference, Yaker

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(Us 6,230,186 B1) clearly and explicitly teach all the limitations of claims 1, 3 and 4.

After further searching and consideration, Jordan, Jr. (US 7,228,334 B1) has been cited to teach some of the missing limitations not taught by Yaker including the previously stated allowable features of claim 2. Fishman et al. (US 2002/0103935 A1) has also been cited to teach the missing limitations of claim 9-13.

10. For the reasons above, claims 1-24 have been rejected and remain pending.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Michael Won/

Primary Examiner

June 26, 2007